Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETER SCHERTL and JOSEF SANDERS

Appeal No. 2003-1241
Application No. 09/808,433

ON BRIEF

Before GARRIS, DELMENDO, and POTEATE, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1-7 which are all of the claims remaining in the application.

The subject matter on appeal relates to a composition comprising a mixture of a particular type of iron compound with a cyclopentadiene derivative and 1,4-dichloro-2-butene, 3,4-dichloro-1-butene or a mixture of the two. Further details of this appealed subject matter are set forth in representative independent claim 1, a copy of which taken from the appellants' specification is appended to this decision.

The references set forth below are relied upon by the examiner in the rejection before us:

Stahl et al. (Stahl) 3,049,573 Aug. 14, 1962

Olive et al. (Olive), "Kinetics and Mechanism of the Iron Catalyzed Positional Isomerization of Dichlorobutenes", Journal of Organometallic Chemistry, Vol. 29, pp. 307-311 (1971).

All of the claims on appeal stand rejected under 35 USC § 103(a) as being unpatentable over Olive in view of Stahl.[1]

We refer to the Brief and Reply Brief and to the Answer for a complete exposition of the opposing viewpoints expressed by the appellants and by the examiner concerning the above noted rejection.

OPINION

We will sustain this rejection for the reasons which follow.

Although the examiner's statement of rejection is based on § 103 and refers to Olive in view of Stahl, the rejection before us is actually based upon the examiner's repeatedly expressed position that "[t]he claimed composition reads on the composition taught by Olive" (Answer, page 5). In essence, the examiner believes that the soluble iron complex, namely, cyclopentadienyl iron dicarbonyl dimer, of Olive would disassociate during its disclosed use as an isomerization catalyst for dichlorobutenes

[1] On page 2 of the Brief, the appellants state that "[c]laims 1-7 stand or fall together". Therefore, in assessing the merits of the rejection before us, we will focus on independent claim 1 and will consider remaining claims 2-7 to stand or fall with claim 1. See 37 CFR § 1.192(c)(7) (2002).

into iron carbonyl and cyclopentadiene constituents that correspond to the constituents formed when the appellants' iron carbonyl and cyclopentadiene are admixed with 1,4-dichloro-2-butene and/or 3,4-dichloro-1-butene in accordance with the here claimed composition. As phrased in the last sentence on page 3 of the Answer, "the Examiner takes the position that it does not matter whether you add the iron compound to the mixture separate from the cyclopentadiene [as in the appellants' claimed composition], or as an iron compound-cyclopentadienyl complex [as in Olive] the resulting composition will still be the same".

Similarly, although the Brief and Reply Brief contain general arguments in opposition to an obviousness conclusion, the appellants specifically and repeatedly argue that they have "submitted the comparative data [of record] to illustrate that the claimed composition does not read on the mixture taught by Olive" (Reply Brief, page 3). This comparative data is presented in the Declaration by Peter Schertl under 37 CFR § 1.132, filed June 13, 2002. According to the appellants, this declaration shows that "the activity of the presently claimed active species was surprisingly always higher than the activity of Olive['s] catalyst" and "[t]herefore, as a result of the testing, the Appellants respectfully submit that the presently claimed composition of the two compounds [i.e., the iron compound and cyclopentadiene derivative of appealed claim 1] forms a different active species during the reaction than Olive['s] catalyst" (Brief, page 4). As stated on page 2 of the Reply Brief, "Appellants are relying on the activity

of the claimed composition compared to that of [the] mixture disclosed in Olive . . .[as shown in the Schertl declaration] for the purpose of illustrating that the compositions [i.e., of appealed claim 1 and Olive] are inherently different".

In light of the foregoing, it is apparent that the pivotal issue on this appeal is whether the record before us supports a determination that the here claimed composition is indistinguishable from the composition which is ultimately formed in the catalyst-containing reaction mixture of Olive. From our perspective, a reasonable basis exists for believing, as the examiner does, that Olive's soluble iron complex of cyclopentadienyl iron dicarbonyl dimer, while in the dichlorobutene reaction mixture, ultimately disassociates into constituents corresponding to those formed when the appellants' iron carbonyl and cyclopentadiene derivative are admixed with 1,4-dichloro-2-butene and/or 3,4-dichloro-1-butene pursuant to appealed claim 1. Further, the appellants do not contest the reasonableness of the examiner's aforementioned belief. Instead, the appellants have submitted the Schertl declaration of record in an attempt to show that their claimed composition in fact is different from the composition formed during use of Olive's catalyst. This attempt by the appellants is in conformance with well established legal principles.

To wit, it is well settled that, where the claimed and prior art products, such as the compositions under review, are identical or substantially identical, the Patent and Trademark Office can require an applicant to prove that the prior art products do not

necessarily or inherently possess the characteristics of his claimed product. Whether the rejection is based on "inherency" under 35 USC § 102, on "prima facie obviousness" under 35 USC § 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the inability of the Patent and Trademark Office to manufacture products or to obtain and compare prior art products. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433-34 (CCPA 1977).

It is the appellants' basic position that the Schertl declaration shows the here claimed composition possesses higher activity than Olive's composition. Concerning this declaration, the examiner points out that the appellants' tested composition does not exhibit significantly higher activity after a reaction time of thirty minutes and that Olive's tested composition actually exhibits a higher activity at 140°C after a reaction time of 180 minutes. In response, the appellants state that, "[a]fter the first thirty minute, the competition reaction has started, so that the results of the activities cannot be compared after this time" (Brief, page 4).

We regard this declaration evidence as insufficient to carry the appellants' burden of showing that their claimed composition differs from the composition ultimately formed during use of the Olive catalyst. While these compositions may differ initially, for example, during the first thirty minutes of reaction time, this is not surprising since Olive's catalyst complex would not be expected to immediately disassociate into the iron and ligand constituents which effect the mechanism of the isomerization reaction in

question (e.g., see the first full paragraph on page 310 of Olive). More importantly, the declaration evidence begs the issue of whether Olive's catalyst complex will at some point during the reaction, for example, after a reaction time of 180 minutes, disassociate into constituents which are the same as those of the appellants' claimed composition.

With further regard to this matter, we here reiterate the earlier mentioned point that the comparative data of the Schertl declaration shows similar activities for Olive's tested composition and the appellants' tested composition after a reaction time of, for example, 180 minutes. As previously mentioned, the appellants state that these similar activities after the first thirty minutes are due to the competition reaction. However, it is also conceivable that these similar activities are due to Olive's catalyst complex disassociating more completely as the reaction time increases.

Thus, at best, the declaration evidence is simply inconclusive as to whether the here claimed composition is actually different from the composition which is ultimately formed during use of Olive's catalyst complex. It follows that the appellants have failed to carry their above discussed burden of proof. We shall sustain, therefore, the examiner's § 103 rejection of all appealed claims as being unpatentable over Olive in view of Stahl.[2]

The decision of the examiner is affirmed.

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[2] A discussion of the Stahl reference is unnecessary in light of our disposition of this appeal.

No period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

BRADLEY R. GARRIS Administrative Patent Judge	)
ROMULO H. DELMENDO Administrative Patent Judge	) BOARD OF PATENT) APPEALS) AND) INTERFERENCES
LINDA R. POTEATE Administrative Patent Judge	)

BRG/yrt

BAYER POLYMERS LLC
100 Bayer Road
Pittsburgh, PA 15205